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10/734,494

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EXAMINER

KHANNA, MADHU

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/734,494 | Applicant(s) MULLER ET AL. | |
| | Examiner MADHU KHANNA | Art Unit 2451 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Amendment filed on 10/14/2008 under 37 C.F.R. 1.111. Claims 1 and 4-10 were previously presented and claims 1 and 4-10 remain pending.

Response to Arguments

2. Applicant's arguments filed 10/14/2008 have been fully considered but they are not persuasive. Applicant argues that the applied references fail to teach the limitation of claim 1, specifically, "modifying a temporary reception list in response to at least one of a determination of an occurrence of a retrospective activity in a user-defined time period and a determination of a prospective activity scheduled to occur in a user-defined time period".

In response to the above argument, Curbow teaches scanning a user's calendar for scheduled events, such as an upcoming meeting, in order to bring to the attention of the user messages relating to the event. One would recognize that it would be advantageous for a user to be reminded of upcoming events and have easy access to information regarding recent events and the people associated with these events. Curbow's invention addresses the issue that a user will most likely be concerned with currently pending calendar events. This is true regardless if the user is utilizing an e-mail system or an instant messaging system, as they comprise the similar feature of immediate communication over a network between users. It would therefore be obvious

to utilize the teachings of Curbow in an environment such as Roskind that organizes and personalizes instant message buddy lists based on current relevance.

Further, it is argued that because a set of rules are used to determine which emails qualify for notification, that Curbow does not teach the claimed invention. However, one of ordinary skill in the art would realize that in order to provide instructions such that a retrospective or prospective activity trigger an event, a rule must be set in advance specifying the time period within which these activities are to be determined. Therefore, the claimed invention inherently includes the process disclosed by the applied references.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roskind (Pub. No. US 2003/0065721) in view of Curbow et al. (Pub. No. US 2003/0222765) (referred to as Curbow hereafter).

Regarding claim 1, Roskind teaches a method for managing interruptions to a network user, the interruptions being generated by a plurality of senders on a network, the network user having a permanent reception list (e.g. Buddies, 816 of FIG. 8) the method comprising:

modifying a temporary reception list (e.g. Recent Contacts) in response to at least one of a determination of an occurrence of a retrospective activity and a determination of a prospective activity (screen names are added to and removed from the Recent Contacts group as IM sessions are opened and closed, and/or as membership limits are imposed on the Recent Contacts group, [0110]), the permanent reception list and temporary reception list (e.g. Buddies group 816 and Recent Contacts group 812 of FIG. 8) each indicating at least one sender from whom the network user is willing to accept an interruption (e.g. preferences may be set to allow only certain users (e.g., user's included in the subscriber's buddy list) to contact the recipient, [0068]);

receiving an interruption from one of the senders on the network (the recipient receives the instant message from the host, [0085]); and

presenting the interruption to the network user if one of the permanent reception list and the temporary reception list (e.g. Buddies group 816 and Recent Contacts group 812 of FIG. 8) includes an entry associated with the one of the senders on the network

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(acceptance may occur automatically if the sender is included on a buddy list maintained by the recipient, [0086]).

Roskind does not disclose a user-defined time period for the retrospective and prospective activities, or that the retrospective and prospective activities are activities that are independent of communications having simultaneous participation between the network user and another network user.

Curbow teaches an activity (e.g. meeting) to occur in a user-defined (pre-selected rules set or preferences) time period (the meeting time compared to the present time, [0017]), the retrospective and prospective activities being activities that are independent of communications having simultaneous participation between the network user and another network user (if an upcoming event is present in the user's calendar or database, [0016]).

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to utilize a pre-selected time frame for defining upcoming or past calendar events in the system/method of Roskind as suggested by Curbow in order to allow the user to specify the notifications which the user wishes to be informed of. One would be motivated to combine these teachings to give each individual user an opportunity to select how much time the user desires to prepare for, finalize and be reminded of particular events.

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Regarding claim 4, Curbow teaches the method of claim 1 wherein the retrospective and prospective activities comprise calendar-based entries established by the user (if an upcoming event is present in the user's calendar or database, [0016]).

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roskind-Curbow in view of Brown et al. (Pub No.: US 2003/0055908) (referred to as Brown hereafter).

Regarding claim 5, although Curbow teaches determining the prioritization of a calendar event [0017], Roskind-Curbow do not disclose receiving, comparing and presenting an interruption with an urgency value.

Brown teaches the method of claim 1 wherein the step of presenting the interruption further comprises:

receiving an urgency value (priority value) associated with the interruption (message request);

comparing the urgency (priority) value with an interruption threshold value (priority requirement) defined by the network user; and

presenting the interruption (throughput of the message) to the network user (receiving user) if the urgency value exceeds the threshold value (whether the message request meets the priority requirement, [0060]).

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to utilize an urgency value with an incoming message in the system/method of Roskind-Curbow as suggested by Brown in order to provide more user specific preferences regarding blocking messages from other clients. One would be motivated to combine these teachings because in doing so a user could receive important messages, while ignoring undesirable ones, rather than blocking all messages when the user is busy.

5. Claim 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roskind-Curbow in view of Kaminsky et al. (Pub. No.: 2005/0055405) (referred to as Kaminsky hereafter).

Regarding claim 7, although Roskind teaches notification settings (e.g., alerts) [0104] and Curbow teaches client notification [0026]-[0027], Roskind-Curbow do not explicitly disclose presenting an alert to the user if the sender is included in the reception list.

Kaminsky teaches the method of claim 1 wherein presenting the interruption (indicating that IM text is available) comprises presenting an alert (visual display) to the network user if one of the permanent reception list and the temporary reception list (buddy list) includes an entry associated with the one of the senders [0043].

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to utilize an alert, such as visual display, in the system/method of

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Roskind-Curbow as suggested by Kaminsky in order to indicate to a user that an IM is available. One of ordinary skill in the art would recognize that methods of alerting a user of an IM are utilized in the instant messaging environment because without an alert, a user would not be aware of an arriving message. One would be motivated to combine these teachings because it further specifies the user alert preferences taught by Roskind-Curbow and explicitly discloses how a user is instantly notified when a priority contact wishes to communicate with the user.

Regarding claim 10, the method of claim 7 further comprising providing expanded information (current status) for the one of the senders (someone on his buddy list) to the network user in response to a user request (Kaminsky: hover message, page 6 [0069]).

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roskind-Curbow-Kaminsky in view of Alexander et al. (US Patent # 6,988,128) (referred to as Alexander hereafter).

Regarding claim 6, Roskind-Curbow-Kaminsky teach the method of claim 1 further comprising:

generating a generic status message (Kaminsky: participants identified in the "customers" category receive an "out of office" icon, [0068]) if the permanent reception list and the temporary reception list do not include an entry associated with the sender

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(Kaminsky: determined by classification information of the message sender not being in the recipient's buddy list, [0059]) of the user status request (instant message); and

generating a customized status message (e.g. "bio-haard") if one of the permanent reception list and the temporary reception list (buddy list "friends" category) includes an entry associated with the sender of the user status request (instant message) [0068]. However, although Roskind-Kaminsky teach enabling an IM user to display another user's current status (Kaminsky: [0069]), Roskind-Kaminsky do not explicitly teach receiving a user status request from one of the senders.

Alexander teaches receiving a user status request (detecting in incoming request for instant messaging status for the user) from one of the senders (column 3 lines 60-62).

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to utilize receiving a user status request from one of the senders in the system/method of Roskind-Curbow-Kaminsky as suggested by Alexander in order to maximize the use of the calendar to better serve the user. One would be motivated to combine these teachings because in doing so this information could be used in an automated manner to dynamically determine a calendar owner's availability and dynamically generate an automated response, further simplifying the demands on the user.

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7. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roskind-Curbow-Kaminsky in view of Daniell et al. (Pub. No.: US 2004/0068545) (referred to as Daniell hereafter).

Regarding claim 8, Roskind-Curbow-Kaminsky teach the method of claim 7, wherein the alert comprises a signal that an interruption has been requested, and an identification of the at least one of the senders (indication of the message sender) is stored in a table (distinct folder) for inspection by the user (Kaminsky: [0042]). However, Roskind-Kaminsky do not explicitly disclose the alert including a portion of the message.

Daniell teaches at least one portion of an initial message from one of the senders (received message) to be previewed by the user [0059].

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to utilize previewing a portion of a received message in the system/method of Roskind-Curbow-Kaminsky as suggested by Daniell in order to provide information to the receiver regarding the content of the message so that the receiver can decide if he/she would prefer to read the entire message at that time or a later time. One would be motivated to combine these teachings because it would enhance the personalization and preferences of a user by giving the user more options as to how he/she receives messages, without increasing complexity.

Regarding claim 9, wherein the alert comprises at least one of a portion of an initial message from the one of the senders (Daniell: "Preview" window, page 5 [0059]) and an

identification of the one of the senders (Kaminsky: indication of the message sender, page 3 [0042]).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MADHU KHANNA whose telephone number is (571)270-3629. The examiner can normally be reached on Monday-Thursday 8:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. K./

Examiner, Art Unit 2451

/Salad Abdullahi/

Primary Examiner, Art Unit 2457